

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): REICH ET AL.

Group Art Unit: 3628

Serial No.: 09/877,439

Examiner: DASS, HARISH T

Filed: June 8, 2001

For: Method and System for Automated Transaction Compliance Processing

RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In Response to the Official Action dated March 1, 2006, Applicants respectfully request reconsideration in view of the following amendments and remarks.

Remarks/Arguments begin on page 2 of this paper.

REMARKS

Rejection Under 35 USC § 103

Claims 1-34 have been rejected under 35 U.S.C. § 103 as being unpatentable over the Examiner's assertion of Admitted Prior Art in view of Brendan Coffey "Compliance Moves Forward"(Wall Street & Technology, New York; pg. 28, 3 pages). Applicants respectfully traverse the rejection.

With regard to the Examiner's rejection of claims 1 and 21 and claims depending there from, the Examiner asserts elements of the Background are Admitted Prior Art. Applicants respectfully disagree. Even if the Examiner's assertion was correct, however, the subsequent interpretation of said Background is incorrect. In the rejection, the Examiner claims as Admitted Prior Art "telephone or a written or e-mailed request. Once the TCO receives the request" (Application, pg.2, lines 5-6). This citation is in no way related to either claim 1 element (b), which states "retrieving restrictions associated with the particular instrument form a collection of restrictions", or to claim 21 element (b), which states "issue a query to the list server to obtain restrictions related to the particular instrument". Should a telephone or e-mail request be used as a "collection of restrictions", such use would not result in the claimed invention, and would in fact result in continuous calls or references to a request. Therefore, the citation does not satisfy the claimed elements. As the Examiner asserted similar rationale for the rejection of claims 16-20 and claims 22-34 (and any claims depending there from), Applicants believe the above remarks apply equally to those claims as well.

Consequently, the reference(s) cited by the office action do not result in the claimed invention, there was/is no motivation for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed

inventions are not admitted to be prior art. Thus, the Applicants respectfully submit that the supporting remarks and claimed inventions, claims 1-34, all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicants believe that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements were not discussed, Applicants assert that all such remaining and not discussed claim elements, all, also are distinguished over the prior art and reserves the opportunity to more particularly remark and distinguish such remaining claim elements at a later time should it become necessary. Further, any remarks that were made in response to an Examiner objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Examiner objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicants do not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, applicants respectfully request allowance, and the reconsideration and withdrawal of the rejection(s) and/or objection(s).

If a telephone conference would facilitate prosecution of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17209-019.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17209-019

Respectfully submitted,
CHADBOURNE & PARKE, L.L.P.

Dated: June 30, 2006

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